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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/479,000	06/07/95	YOSHIOKA	S 35.C5745CIP/

KNAPP, J. EXAMINER

32M1/0604
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ART UNIT	PAPER NUMBER
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3202

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DATE MAILED: 06/04/96

This is a communication from the examiner in charge of your application
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 134-137, 141-144 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-133, 138-140, 145-154 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 134-137, 141-144 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☒ The ~~corrected or substitute~~ drawings have been received on 6/7/95. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☒ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified ^{COPIES HAVE} copy has ☐ been received ☐ not been received
☒ been filed in parent application, serial no. 07/218,203; filed on 7/13/88
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. Claims 137, 144 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 137 is vague and indefinite because it is comprised of only a single step. The first reason the single step is indefinite is that in line 2 "the steps" are claimed, indicating the claims is to consist of more than just one step. Secondly, a single-step process claim is vague and indefinite because a process, by nature, is more than a single step operation.

Claim 144 is vague and indefinite because it fails to provide enough steps to create the device as claimed. The provision of the fine particles does not alone create a device capable of emitting electrons. A set of electrodes must also be provided to create such a device.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claim 137 is rejected under 35 U.S.C. § 102(b) as being anticipated by Klopfer et al. U.S. Pat. 3,735,186).

See Figures 1-6; and columns 3 and 4.

4. Claims 141-143 are rejected under 35 U.S.C. § 102(b) as being anticipated by Van Gorkom et al. (U.S. 4,370,797).

See column 5, lines 29-57; Figures 8-14; and column 11, line 29, through column 12, line 60.

5. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 134-137 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. U.S. 5,066,883. Although the conflicting claims are not identical, they are not patentably distinct from each other because the product claims teach the claimed elements of the method claims. See claims 1, 9, 16, 37-46, and 48, in particular, of U.S. '883.

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7. Claim 144 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112.

8. The following references are cited as material:

Nomura et al. (U.S. 5,470,265); JA 2-247939(A); JA 4-65050(A); and JA 6-231678(A). Of those references only JA '939 may possibly qualify as prior art based on the various effective filing dates of this case.

9. Any inquiry concerning this communication should be directed to Jeff Knapp at telephone number (703) 308-0667.

Knapp/msm

May 21, 1996

Kenneth J. Ramsey
KENNETH J. RAMSEY
PRIMARY EXAMINER
GROUP 3200